

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS

In re Patent Application of:)	
MAY ET AL.)	Examiner:
)	M. RAMAKRISHNAIAH
Serial No. 10/790,641)	
)	Art Unit: 2614
Filing Date: MARCH 1, 2004)	
)	Attorney Docket No.
For: COMMUNICATIONS SYSTEM)	ID-399 (80211)
PROVIDING TEXT-TO-SPEECH)	
MESSAGE CONVERSION FEATURES)	
USING AUDIO FILTER PARAMETERS)	
AND RELATED METHODS)	
)	

APPELLANTS' APPEAL BRIEF

MS Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellants' Appeal Brief together with the requisite \$510.00 large entity fee for filing a brief. If any additional extension and/or fee is required, authorization is given to charge Deposit Account No. **01-0484**.

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(1) Real Party in Interest

The real party in interest is Research In Motion Limited, assignee of the present application, as recorded at reel 015034, frame 0573.

(2) Related Appeals and Interferences

At present there are no related appeals, judicial proceedings, or interferences.

(3) Status of the Claims

Claims 1, 4-13, 16-21, 24-27, and 30-42 are pending in the application, stand rejected, and are appealed herein. Claims 2-3, 14-15, 22-23, and 28-29 have been canceled.

(4) Status of the Amendments

All amendments have been entered and there are no further pending amendments. A copy of the claims involved in this appeal is attached hereto as Appendix A.

(5) Summary of the Claimed Subject Matter

As discussed in the present application at paragraphs 7-9, the present invention is directed to a mobile wireless communications device **22**. As recited in independent Claim 1, for example, the mobile wireless communications device includes a wireless transceiver **23** and a controller **25** cooperating therewith for receiving text messages from a wireless communications

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network **21**. The controller is switchable between a normal message mode and an audio message mode. The mobile wireless communications device further includes a user interface device **39** connected to the controller for receiving at least one audio mode filter parameter from a user, and a headset output **29** connected to the controller. The controller, when in the audio message mode, selects received text messages based upon the at least one audio mode filter parameter, and outputs audio messages comprising speech generated from the selected text messages via the headset output. The controller switches between the normal message mode and the audio message mode based upon a connection between the headset output and a headset **30**. (Specification page 7, line 5 through page 12, line 10; and Figures 1-2, reproduced below). That is, the controller automatically recognizes when a headset is connected (such as, when the user is about to operate a vehicle or begin jogging) and advantageously enter the audio message mode, providing added convenience for the user.

Independent Claim 13 is directed to a communications system **20** that comprises at least one mobile wireless communications device **22**. The at least one mobile wireless communications device may include a wireless transceiver **23** and a controller **25** cooperating therewith for receiving text messages. The controller is switchable between a normal message mode and an audio message mode. The at least one mobile wireless communications device also includes a user interface device **39** connected to the controller for receiving at least one audio mode

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filter parameter from a user, and a headset output **29** connected to the controller. The controller, when in the audio message mode, selects received text messages based upon the at least one audio mode filter parameter, and outputs audio messages comprising speech generated from the selected text messages via the headset output. The controller switches between the normal message mode and the audio message mode based upon a connection between the headset output and a headset **30**. The communications system also comprises a wireless communications network **21** for sending the text messages to the at least one mobile wireless communications device. (Specification page 7, line 5 through page 12, line 10; and Figures 1-2, reproduced below).

Independent Claim 21 is directed to a method for using a mobile wireless communications device **22** comprising a user interface device **39** and a headset output **29**. The mobile wireless communications device is switchable between a normal message mode and an audio message mode. The method may comprise receiving (Block **51**) text messages from a wireless communications network **21**, receiving (Block **52**) at least one audio mode filter parameter from a user via the user interface device, and switching (Block **63**) the mobile wireless communications device between the normal message mode and the audio message mode based upon a connection between the headset output and a headset **30**. The method also includes, when in the audio message mode, selecting (Block **54**) received text messages based upon the at least one audio mode filter parameter, and outputting (Block **55**) audio messages

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comprising speech generated from the selected text messages via the headset output. (Specification page 7, line 5 through page 12, line 10 & page 14, line 25 through page 15, line 25; and Figures 1-2 & 5-6, reproduced below).

Independent Claim 27 is directed to a computer-readable medium for use with a mobile wireless communications device **22** comprising a user interface device **39** and a headset output **29**. The mobile wireless communications device is switchable between a normal message mode and an audio message mode. The computer-readable medium has computer-executable instructions for causing the mobile wireless communications device to perform steps comprising receiving text messages from a wireless communications network **21**, receiving at least one audio mode filter parameter from a user via the user interface device, and switching between the normal message mode and the audio message mode based upon a connection between the headset output and a headset **30**. The step also include, when in the audio message mode, selecting received text messages based upon the at least one audio mode filter parameter, and outputting audio messages comprising speech generated from the selected text messages via the headset output. (Specification page 7, line 5 through page 12, line 10; and Figures 1-2, reproduced below).

Independent Claim 33 is directed to a mobile wireless communications device **22** that may include a wireless transceiver **23** and a controller **25** cooperating therewith for receiving text messages from a wireless communications network **21**. The

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controller is switchable between a normal message mode and an audio message mode. The mobile wireless communications device may also include a user interface device **39** connected to the controller for receiving at least one audio mode filter parameter from a user, and an audio output **29** connected to the controller. The controller, when in the audio message mode, selects received text messages based upon the at least one audio mode filter parameter, and outputs audio messages comprising speech generated from the selected text messages via the audio output. The controller switches between the normal message mode and the audio message mode based upon a connection between the audio output and an audio device **30**. (Specification page 7, line 5 through page 12, line 10; and Figures 1-2, reproduced below).

Independent Claim 38 is directed to a method for using a mobile wireless communications device **22** comprising a user interface device **39** and an audio output **29**. The mobile wireless communications device is switchable between a normal message mode and an audio message mode. The method comprises receiving (Block **51**) text messages from a wireless communications network **21**, receiving (Block **52**) at least one audio mode filter parameter from a user via the user interface device, and switching (Block **63**) the mobile wireless communications device between the normal message mode and the audio message mode based upon a connection between the audio output and an audio device **30**. The method also includes, when in the audio message mode, selecting (Block **54**) received text messages based upon the at least one audio mode

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filter parameter, and outputting (Block 55) audio messages comprising speech generated from the selected text messages via the audio output. (Specification page 7, line 5 through page 12, line 10 & page 14, line 25 through page 15, line 25; and Figures 1-2 & 5-6, reproduced below).

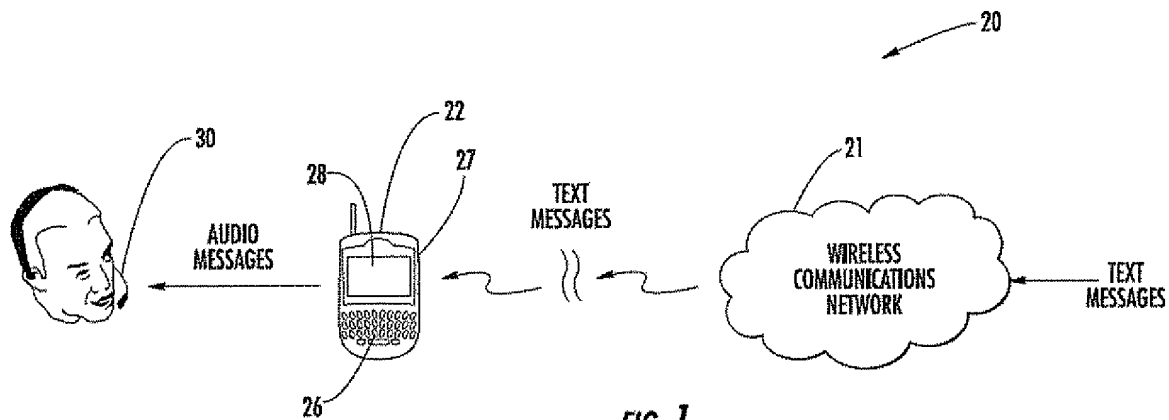


FIG. 1

Figure 1 of the Present Application

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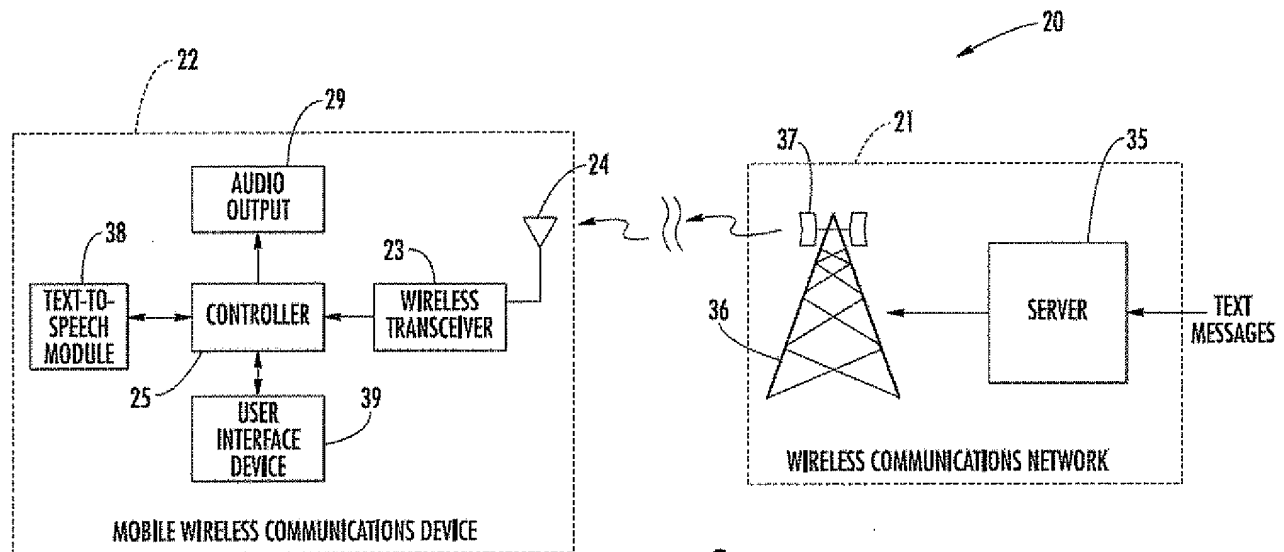


Figure 2 of the Present Application

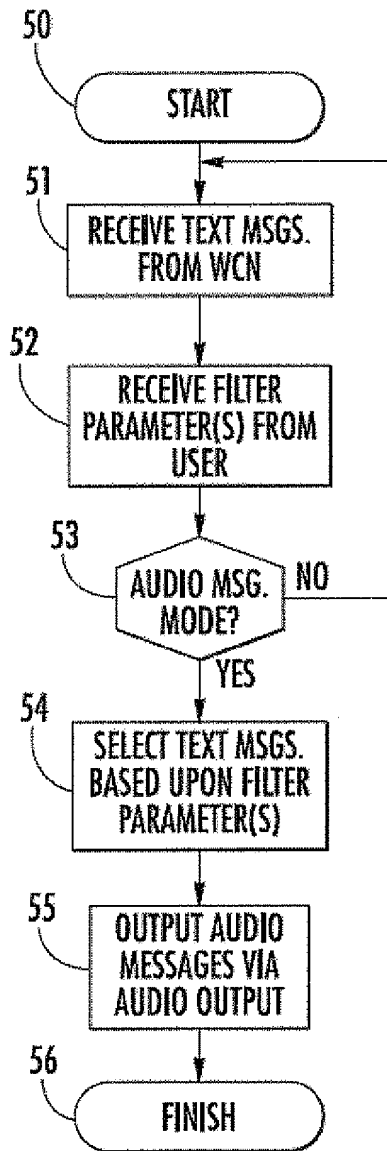


FIG. 5

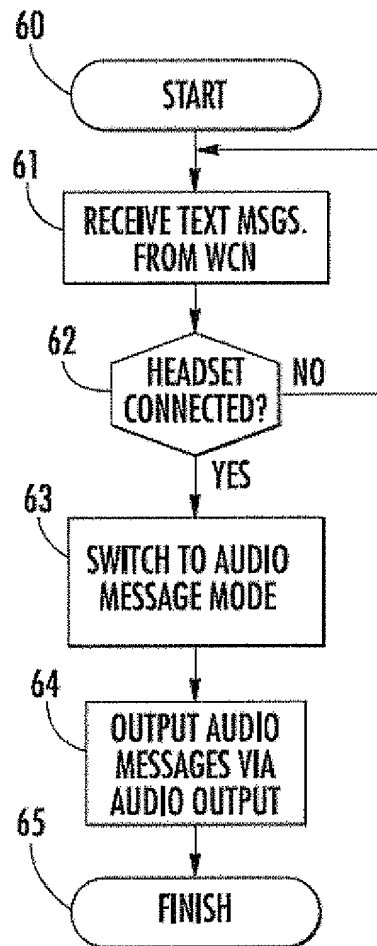


FIG. 6

Figures 5-6 of the Present Application

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(6) Grounds of Rejection to be Reviewed On Appeal

The Examiner rejected Claims 1, 4-5, 6-12, 13, 16-18, 20-21, 24-26, 27, 30-36, and 38-41 under 35 U.S.C. §103(a) over U.S. Patent No. 6,181,956 to Koskan in view of U.S. Patent Application Publication No. 2004/0186728 to Kuboyama et al.

The Examiner rejected Claim 19 under 35 U.S.C. §103(a) over the Koskan patent in view of the Kuboyama et al. application and further in view of U.S. Patent No. 6,421,707 to Miller et al.

The Examiner rejected Claims 37 and 42 under 35 U.S.C. §103(a) over the Koskan patent in view of the Kuboyama et al. application and further in view of U.S. Patent No. 6,772,143 to Hung.

(7) Argument

As will be described in greater detail below, Appellants respectfully submit that the Examiner's proposed combination of Koskan and Kuboyama et al. is improper and request that the Board of Patent Appeals and Interferences reverse the Examiner and withdraw the rejections of the claims.

A. THE REJECTION OVER THE KOSKAN PATENT IN VIEW OF THE KUBOYAMA ET AL. APPLICATION

The Examiner rejected independent Claims 1, 13, 21, 27, 33, and 38 over Koskan in view of Kuboyama et al. Koskan discloses a communications device (i.e., cell phone) to be worn by a user that is coupled to a headset by a communication link.

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The communications device is operable in first and second operating modes. When in the first operating mode, the device receives and presents text-based messages in a human readable form to the user via a user interface. When in the second operating mode, the received message is converted to an audible form using a text-to-speech synthesizer and presented to the user via the headset. (Col. 2, lines 38-52). In one embodiment, the communication device automatically switches to the second operating mode based upon a characteristic of the received message, such as, a keyword present in the received message or an indication of the message type. (Col. 3, lines 9-15).

The Examiner correctly notes that Koskan fails to disclose switching between the normal message mode and the audio message mode based upon a connection between the headset output and a headset, as recited by the independent claims, and looks to Kuboyama et al. to supply this deficiency. Kuboyama et al. discloses a communication device comprising a headset coupled to internal circuitry by either a wire or a wireless connection. (Paragraph 55). Determination means detects when the headset is connected to the communication device and outputs text information to a display when there is no connection, and to the headset when there is a connection. (E.g., Paragraphs 9-11, 23-25, 55-56, and 60). Kuboyama et al. teaches that this particular functionality is intended to avoid accidental disclosure of private text information over the onboard audio speaker of the

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communication device in a public place. (E.g., Paragraphs 5, 62, 80, 85).

The Examiner contended that a person of ordinary skill in the art would consider it obvious to modify Koskan to include the determination means of Kuboyama et al. for detecting when the headset is connected to the communication device, for outputting text information to the display when there is no connection, and for outputting to the headset when there is a connection. The Examiner contended that the person of ordinary skill in the art would be motivated by "the arrangement [] providing one method among many possible methods, to automatically direct audio output to the headset based on detection of connection status of headset to the communication device as taught by Kuboyama."

Appellants submit that the Examiner's proposed combination of Koskan and Kuboyama et al. is improper because the references teach away from such a selective combination, and because the modification of Koskan changes its principle of operation. More particularly, Koskan discloses that "[t]he device operating mode is preferably user selectable." (Col. 2, lines 5-6). Koskan discloses that the user interface of the communication device includes a selectable mode switch. The user of Koskan manipulates the selectable mode switch to toggle the communications device between first (display mode) and second operating modes (headset mode). (Col. 2, lines 33-34). Therefore, Appellants submit that the person of ordinary skill in the art would be taught away from modifying Koskan to switch

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between modes automatically based upon the connection to the headset since Koskan expressly teaches that user controlled toggling between modes is desired.

Moreover, it appears that Koskan and Kuboyama et al. address different problems, and, for this reason also, would lead the person of ordinary skill in the art away from such a selective combination. For example, Koskan addresses the problem where the user is engrossed in a physical activity or within an environment that prevents access to the communications device. (Col. 1, lines 24-37; & Figure 1). Ostensibly, the reason why Koskan prefers the selectable mode switch is to allow the user to toggle the communications device between different modes prior to such an activity necessitating the use of the headset.

Differently, Kuboyama et al. addresses a privacy concern related to having text messages audibly announced in a public place. (Paragraph 5). The switching between modes based upon connection to the headset is intended to address the privacy concern, i.e. outputting to audio only when the headset is attached. The automatic mode switching of Kuboyama et al. appears to be inapplicable to the purpose of Koskan, i.e. switching when environmental or physical factors prevent user access to the device, since these same factors would prevent the user from connecting the headset to the communications device, for example, in wireless connection embodiments, by reducing physical displacement between the headset and communications

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device, and in wired embodiments, by coupling a wire between the headset and the communications device.

Indeed, in Kuboyama et al., the toggling of modes based on connection between the communications device and the headset is intended to alleviate the problem of the user forgetting to toggle the manual switch. Because of all these reasons, Appellants submit that the person of ordinary skill in the art would be taught away from the Examiner's proposed combination of Koskan and Kuboyama et al., and would also consider such a selective combination to change the principle of operation of Koskan.

Accordingly, it is submitted that independent Claims 1, 13, 21, 27, 33, and 38 are patentable over the prior art. Their respective dependent claims, which recite yet further distinguishing features, are also patentable over the prior art and require no further discussion herein.

B. THE REJECTION OVER THE KOSKAN PATENT IN VIEW OF THE KUBOYAMA ET AL. APPLICATION AND THE MILLER ET AL. PATENT

The Examiner rejected Claim 19 over the Koskan patent in view of the Kuboyama et al. application and further in view of the Miller et al. patent. Appellants submit that the patentability of independent Claims 1, 13, 21, 27, 33, and 38 is established by the arguments above. Accordingly, their respective dependent claims, which recite yet further

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distinguishing features and include Claim 19, are also patentable over the prior art and require no further discussion herein.

C. THE REJECTION OVER THE KOSKAN PATENT IN VIEW OF THE KUBOYAMA ET AL.

APPLICATION AND THE HUNG PATENT

The Examiner rejected Claims 37 and 42 over the Koskan patent in view of the Kuboyama et al. application and further in view of the Hung patent. Appellants submit that the patentability of independent Claims 1, 13, 21, 27, 33, and 38 is established by the arguments above. Accordingly, their respective dependent claims, which recite yet further distinguishing features and include Claims 37 and 42, are also patentable over the prior art and require no further discussion herein.

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CONCLUSIONS

In view of the foregoing arguments, it is submitted that all of the claims are patentable over the prior art. Accordingly, the Board of Patent Appeals and Interferences is respectfully requested to reverse the earlier unfavorable decision by the Examiner.

Respectfully submitted,



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APPENDIX A - CLAIMS ON APPEAL
FOR U.S. PATENT APPLICATION SERIAL NO. 10/790,641

1. A mobile wireless communications device comprising:
a wireless transceiver and a controller cooperating
therewith for receiving text messages from a wireless
communications network, said controller being switchable between
a normal message mode and an audio message mode;

a user interface device connected to said controller
for receiving at least one audio mode filter parameter from a
user; and

a headset output connected to said controller;
said controller, when in the audio message mode,
selecting received text messages based upon the at least one
audio mode filter parameter, and outputting audio messages
comprising speech generated from the selected text messages via
said headset output;

said controller switching between the normal message
mode and the audio message mode based upon a connection between
said headset output and a headset.

4. The mobile wireless communications device of Claim
1 wherein said headset output comprises a wireless headset output
for establishing a wireless connection with a headset.

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5. The mobile wireless communications device of Claim 1 wherein said headset output comprises a headset jack for a wired headset.

6. The mobile wireless communications device of Claim 1 wherein said controller switches between the normal message mode and the audio message mode based upon an audio message mode command provided by a user via said user interface device.

7. The mobile wireless communications device of Claim 1 further comprising a text-to-speech module for cooperating with said controller to convert the selected text messages to the audio messages.

8. The mobile wireless communications device of Claim 1 wherein the at least one audio message filter parameter comprises a sender identifier.

9. The mobile wireless communications device of Claim 1 wherein the at least one audio message filter parameter comprises at least one keyword.

10. The mobile wireless communications device of Claim 1 wherein said user interface device comprises a keypad connected to said controller.

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11. The mobile wireless communications device of Claim 1 further comprising a display connected to said controller for displaying the text messages.

12. The mobile wireless communications device of Claim 1 wherein said wireless transceiver comprises a cellular transceiver.

13. A communications system comprising:
at least one mobile wireless communications device
comprising:

a wireless transceiver and a controller
cooperating therewith for receiving text messages, said
controller being switchable between a normal message
mode and an audio message mode,

a user interface device connected to said
controller for receiving at least one audio mode filter
parameter from a user, and

a headset output connected to said controller,
said controller, when in the audio message mode,
selecting received text messages based upon the at
least one audio mode filter parameter, and outputting
audio messages comprising speech generated from the
selected text messages via said headset output

said controller switching between the normal
message mode and the audio message mode based upon a

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connection between said headset output and a headset;
and

a wireless communications network for sending the text messages to said at least one mobile wireless communications device.

16. The communications system of Claim 13 wherein said headset output comprises a wireless headset output for establishing a wireless connection with the headset.

17. The communications system of Claim 13 wherein said controller switches between the normal message mode and the audio message mode based upon an audio message mode command provided by a user via said user interface device.

18. The communications system of Claim 13 wherein said at least one wireless communications device further comprises a text-to-speech module for cooperating with said controller to convert the selected text messages to the audio messages.

19. The communications system of Claim 13 wherein said controller is also for generating conversion requests for the selected text messages and cooperating with the wireless transceiver to forward the conversion requests to said wireless communications network; wherein said wireless communications network receives the conversion requests and further comprises a

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text-to-speech module for converting the selected text messages to audio messages based upon the conversion requests, and wherein said wireless communications network sends the audio messages to said at least one wireless communications device.

20. The communications system of Claim 13 wherein the at least one audio message filter parameter comprises at least one of a sender identifier and a keyword.

21. A method for using a mobile wireless communications device comprising a user interface device and a headset output, the mobile wireless communications device being switchable between a normal message mode and an audio message mode, the method comprising:

receiving text messages from a wireless communications network, and receiving at least one audio mode filter parameter from a user via the user interface device;

switching the mobile wireless communications device between the normal message mode and the audio message mode based upon a connection between the headset output and a headset; and

when in the audio message mode, selecting received text messages based upon the at least one audio mode filter parameter, and outputting audio messages comprising speech generated from the selected text messages via the headset output.

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24. The method of Claim 21 wherein the headset output comprises a wireless headset output for establishing a wireless connection with the headset.

25. The method of Claim 21 further comprising switching between the normal message mode and the audio message mode based upon an audio message mode command provided by a user via the user interface device.

26. The method of Claim 21 further comprising converting the selected text messages to the audio messages at the mobile wireless communications device prior to outputting.

27. A computer-readable medium for use with a mobile wireless communications device comprising a user interface device and a headset output, the mobile wireless communications device being switchable between a normal message mode and an audio message mode, the computer-readable medium having computer-executable instructions for causing the mobile wireless communications device to perform steps comprising:

receiving text messages from a wireless communications network, and receiving at least one audio mode filter parameter from a user via the user interface device;

switching between the normal message mode and the audio message mode based upon a connection between the headset output and a headset; and

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when in the audio message mode, selecting received text messages based upon the at least one audio mode filter parameter, and outputting audio messages comprising speech generated from the selected text messages via said headset output.

30. The computer-readable medium of Claim 27 wherein the headset output comprises a wireless headset output for establishing a wireless connection with the headset.

31. The computer-readable medium of Claim 27 further comprising computer-executable instructions for causing the mobile wireless communications device to perform a step of switching between the normal message mode and the audio message mode based upon an audio message mode command provided by a user via the user interface device.

32. The computer-readable medium of Claim 27 further comprising computer-executable instructions for causing the mobile wireless communications device to perform a step of converting the selected text messages to the audio messages prior to outputting.

33. A mobile wireless communications device comprising:

a wireless transceiver and a controller cooperating therewith for receiving text messages from a wireless

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communications network, said controller being switchable between a normal message mode and an audio message mode;

a user interface device connected to said controller for receiving at least one audio mode filter parameter from a user; and

an audio output connected to said controller;

said controller, when in the audio message mode, selecting received text messages based upon the at least one audio mode filter parameter, and outputting audio messages comprising speech generated from the selected text messages via said audio output;

said controller switching between the normal message mode and the audio message mode based upon a connection between said audio output and an audio device.

34. The mobile wireless communications device of Claim 33 wherein the audio device comprises a wired headset, and wherein said audio output comprises a headset jack.

35. The mobile wireless communications device of Claim 33 wherein the audio device comprises a wireless headset, and wherein said audio output comprises a wireless headset output for establishing a wireless connection with the wireless headset.

36. The mobile wireless communications device of Claim 33 wherein said controller switches between the normal message

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mode and the audio message mode based upon an audio message mode command provided by a user via said user interface device.

37. The mobile wireless communications device of Claim 33 wherein the at least one audio message filter parameter comprises at least one of a sender identifier and at least one keyword.

38. A method for using a mobile wireless communications device comprising a user interface device and an audio output, the mobile wireless communications device being switchable between a normal message mode and an audio message mode, the method comprising:

receiving text messages from a wireless communications network, and receiving at least one audio mode filter parameter from a user via the user interface device;

switching the mobile wireless communications device between the normal message mode and the audio message mode based upon a connection between the audio output and an audio device; and

when in the audio message mode, selecting received text messages based upon the at least one audio mode filter parameter, and outputting audio messages comprising speech generated from the selected text messages via the audio output.

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39. The method of Claim 38 wherein the audio device comprises a wired headset, and wherein the audio output comprises a headset jack.

40. The method of Claim 38 wherein the audio device comprises a wireless headset, and wherein the audio output comprises a wireless headset output for establishing a wireless connection with the wireless headset.

41. The method of Claim 38 wherein switching further comprises switching between the normal message mode and the audio message mode based upon an audio message mode command provided by a user via the user interface device.

42. The method of Claim 38 wherein the at least one audio message filter parameter comprises at least one of a sender identifier and at least one keyword.

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APPENDIX B - EVIDENCE APPENDIX

PURSUANT TO 37 C.F.R. § 41.37(c)(1)(ix)

None.

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APPENDIX C - RELATED PROCEEDINGS APPENDIX
PURSUANT TO 37 C.F.R. § 41.37(c)(1)(x)

None.